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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/686,711	10/10/2000	Pallab K. Chatterjee	020431.0706	4657

53184 7590 06/12/2007

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EXAMINER	
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ART UNIT	PAPER NUMBER
3692	

MAIL DATE	DELIVERY MODE
06/12/2007	PAPER

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/686,711
Filing Date: October 10, 2000
Appellant(s): CHATTERJEE ET AL.

James E. Walton, Daren C. Davis, Michael Alford and Seven J. Laureanti
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 2, 2007 appealing from the Office action mailed September 23, 2004.

(1) Real Party In Interest

i2 Technologies US Inc.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US PATENT 4,799,156 SHAVIT ET AL.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-11, 13-23 and 25-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Shavit et al. (US Patent 4,799,156, hereafter Shavit).

Re. Claims 1, 13 & 25, Shavit anticipates a computer-implemented marketplace, method and system for providing one or more financial transaction services to participants in connection with commercial transactions involving the participants, comprising:

- a database containing (Col. 2, lines 25-27):
- registration information for one or more types of transactions available to participants through the marketplace (subscription/registration – Col. 6, lines 4-6; transactions available/options – Col. 6, lines 29-31);
- participation criteria for each participant specifying one or more types of transactions in which the participant is willing to participate in association with the marketplace, each participant being pre-qualified to enter into the one or more types of transactions specified in the participation criteria for the participant (Fig. 2; Col. 6, lines 4-9); and
- one or more processes each operable to provide an associated financial transaction service for one or more participants in connection with ongoing transactions involving the participants (Fig.'s 2, 16, 22, 27-30; Col. 8, line 23 – Col. 9, line 42);
- the marketplace operable to initiate a selected process in response to a specified event associated with an ongoing transaction, according to the registration

information and participation criteria, to provide a corresponding financial transaction service to at least one participant involved in the ongoing transaction (Fig.'s 2, 16, 22, 27-30; Col. 8, line 23 – Col. 9, line 42); and

- monitor activities of the at least one participant in the ongoing transaction to assess whether the participant should continue to be pre-qualified to participate in transactions of the same type as the ongoing transaction (Fig. 8, 224-234; Col. 20, l. 64 – Col. 21, l. 36).

Re. Claims 2 & 14, Shavit anticipates a marketplace of Claim 1, wherein at least some of the registration information comprises a time limit for a transaction or one or more aspects thereof (Urgent Shipment - Col. 6, l. 55; late shipment - Col. 10, l. 36).

Re. Claims 3 & 15, Shavit anticipates a marketplace of Claim 1, wherein at least some of the registration information comprises a payment point, the marketplace operable to generate payment instructions for communication to a participant in response to a transaction reaching the payment point (Fig.'s 14 (344), 15 (354), 16 (390); Col. 8, ll. 55-64).

Re. Claims 4 & 16, Shavit anticipates a marketplace of Claim 1, wherein at least some of the participation criteria is selected from the group consisting of item type information, value information, and delivery information (Col. 5, l. 65 – Col. 6, l. 51).

Re. Claims 5 & 17, Shavit anticipates a marketplace of Claim 1, wherein the participation criteria for at least one participant comprise default criteria specifying all types of transactions (Col. 5, l. 65 – Col. 6, l. 51).

Re. Claims 6 & 18, Shavit anticipates a marketplace of Claim 1, wherein the initiated process comprises at least one associated person to assist in providing the corresponding service (Col. 5, l. 34).

Re. Claims 7 & 19, Shavit anticipates a marketplace of Claim 1, wherein the specified event comprises the initiation of the associated commercial transaction (Col. 6, ll. 19-25, 34, 37-38).

Re. Claims 8 & 20, Shavit anticipates a marketplace of Claim 1, wherein the initiated process is operable to initiate a transfer of funds on behalf of the participant (Col. 8, l. 55 – Col. 9, l. 6).

Re. Claims 9 & 21, Shavit anticipates a marketplace of Claim 8, wherein the transfer of funds is made by a financial agent of the participant to a financial agent of a second participant through the marketplace (Col. 8, l. 65 – Col. 9, l. 19; among some agent to agent combinations are bank to bank, lender to bank, or bank to factor,).

Re. Claims 10 & 22, Shavit anticipates a marketplace of Claim 8, wherein the initiated process is operable to generate information for communication to one or more enterprise resource planning (ERP) systems associated with the participant (Col. 1, ll. 5-12; Col. 1, l. 24 –Col. 2, l. 5. ERP systems are computer software systems which link purchasing/materials, accounting and manufacturing. The user systems anticipated by Shavit are the enterprise systems which existed in the middle 1980's and which have grown in sophistication since then. The ASK Manman ERP system was one of the leading old enterprise systems which was then supplanted in the middle 1990's by ERP systems provided by SAS, Baan, Oracle and others).

Re. Claims 11 & 23, Shavit anticipates a marketplace of Claim 1, wherein at least one of the processes is a participant qualification process operable to determine the acceptability of the participant and of one or more financial agents:

- from which the participant may select (Col. 5, l. 66 – Col. 6, l. 51; Col. 8, l. 55 – Col. 9, l.6); and
- from or to which funds may be transferred on behalf of the participant (Col. 5, l. 66 – Col. 6, l. 51; Col. 8, l. 55 – Col. 9, l.6).

Re. Claims 26, 31 & 36, Shavit anticipates software and a method operating at a computer-implemented marketplace for settling a commercial transaction between a buyer and a seller, the software being embodied in a computer-readable medium and when executed operable to:

- receive an order for at least one item from the buyer, the buyer being associated with stored participation criteria accessible to the marketplace that specifies one or more types of transactions in which the buyer is willing to participate in association with the marketplace, the participation criteria indicating that the buyer is willing to participate in purchase transactions, the buyer being pre-

qualified to enter into the one or more types of transactions specified in the participation criteria for the buyer, the order received from the buyer initiating a purchase transaction (Fig. 3; Col. 1, l. 9-36; Col. 5, ll. 16-24; Col. 6, ll. 2-18, 34; Col. 15, ll. 7-13);

- communicate the order to the seller for fulfillment of the order (Col. 2, ll. 21-26; Col. 5, ll. 39-50; Col. 7, ll. 1-5; Col. 8, ll. 12-15);
- receive notification from the seller in response to shipping of the item (Col. 11, ll. 11-21, 55);
- receive notification from the buyer in response to acceptance of the item (Col. 9, ll. 26-27);
- communicate payment instructions to at least one financial agent associated with the buyer (Col. 8, ll. 55-58);
- receive payment from the financial agent associated with the buyer (Col. 8, l. 55 – Col. 9, l. 19);
- communicate the payment to a financial agent associated with the seller (Col. 8, ll. 55-58);
- receive notification from the seller in response to acceptance of the payment (Fig. 15 - managing payee's and payer's statement info.; Fig. 16 – statements and reports);
- communicate accounting information reflecting settlement of the transaction (Fig. 16 – statements and reports); and
- monitor activities of the buyer in the purchase transaction to assess whether the buyer should continue to be pre-qualified to participate in purchase transactions (Fig. 8, 224-234; Col. 20, l. 64 – Col. 21, l. 36).

Re. Claims 27 & 32, Shavit anticipates software of Claim 26, further operable to communicate the order to a financial agent associated with the buyer or the seller (Fig. 2; Col. 5, l. 66 – Col. 6, l. 18; Col. 8, ll. 23 – 41, 55-58).

Re. Claims 28 & 33, Shavit anticipates software of Claim 26, wherein the financial agent associated with the buyer is integral to the buyer (Inherent, e.g. when the buyer is a financial institution).

Re. Claims 29 & 34, Shavit anticipates software of Claim 26, wherein the financial agent associated with the seller is integral to the seller (Inherent, e.g. when the seller is a financial institution).

Re. Claims 30 & 35, Shavit anticipates software of Claim 26, further operable to communicate the accounting information to enterprise resource planning (ERP) functionality associated with the buyer or the seller (Supra. See claims 10 & 22).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. **Claims 37 - 44 are** rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit et al.

Re. Claims 37, 39, 41 & 43, Shavit discloses a system wherein participants are pre-qualified using one or more of:

- one or more qualification ratings (Fig's 3, 4, 6, 8); and
- one or more qualification categories (Col. 6, ll. 9-18).

Shavit does not explicitly disclose one or more qualification rankings. However, Shavit's disclosure in col. 6, ll. 9-51 discloses a variety of optional qualifications a participant can register for which essentially establishes a ranking system established by the different mix and levels of participation of the various participants. It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention that a qualification rankings were suggested by Shavit based on these options offered by Shavit in order to

offer dramatic new automated efficiencies to prospective and current participants in an electronic marketplace system (Shavit, Col. 1, ll. 61- 68).

Re. Claims 38, 40, 42 & 44, Shavit does not explicitly disclose a system wherein the marketplace is further operable to automatically modify the pre-qualification of the at least one participant based on the monitoring of the activities of the participant in the ongoing transaction if such modification is determined to be appropriate. However, Shavit discloses an electronic marketplace wherein the marketplace is further operable to automatically modify a variety of information of participants based on automated interactive information service with the participant's computer information systems, including the activities of the participant in the ongoing transaction (Col. 8, ll. 5-22). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to modify the pre-qualification of the at least one participant based on the monitoring of the activities of the participant in the ongoing transaction if such modification is determined to be appropriate based on the interactive information exchange taught by Shavit to the dramatic new automated efficiencies made available to prospective and current participants in an electronic marketplace system (Shavit, Col. 1, ll. 61- 68).

(10) Response to Argument

ARGUMENT re. Issue No. 1 - Anticipation of Claims 1-11, 13-23 and 25-36:

(A) Claim 1 is exemplary of independent claims 1, 13 and 25 (p. 23, ll. 22-23).

(a) "There is no mention" (in Shavit) "of any participation criteria indicative of "types of transactions in which [a] participant is willing to participate" (p. 24, ll. 18-19).

(b) "Shavit fails to disclose, teach, or suggest a marketplace operable to "monitor activities of the at least one participant in the ongoing transaction to assess whether the participant should continue to be pre-qualified to participate in transactions of the same type as the ongoing transaction" as recited in claim 1" (p. 25, ll. 4-8).

RESPONSE:

(a) A reference is valid for all that it teaches. A reference does not have to use the same language to anticipate an applicant's specific claims language. Such differences

in language is what Appellant relies on to argue his case against the rejection of claim 1. Further, Appellant has not taken advantage of the right to be his own lexicographer in the specification in order to give special meaning to the phrase "participation criteria". As such, the examiner must necessarily give this expression its broadest meaning within the context of the phrase and the entire claim of which it is part (**MPEP 2106, II C**). The context of he phrase "participation criteria" in the specification suggests that these criteria are simply taken from the participant's registration information regarding the registered participant's areas of chosen participation. This interpretation makes sense in the claim limitation in which it is found, namely the participant's willingness to participate in certain activities in the marketplace he has registered to participate with. Shavit teach such participation criteria for a participant by primarily dedicating his teaching to business participants within one industry, although he makes a passing reference to this being possible for multiple industries. His base case focuses on the participants within one industry (Col. 1, l. 45, 61-66; Col. 2, ll. 9-15; Col. 6, ll. 2-4 – within an industry market). As such, each participant is indicating participation criteria in the registration process focused on a specific industry. This is an important underpinning in Shavit without which his invention cannot function. In other words, this is a must in Shavit's teaching. Further, as part of the essential logic by which Shavit's teaching hangs together, Shavit explicitly teaches that each participant is registered to participate in one or more types of transactions, as provided in a lengthy listing of examples in Col. 6, ll. 9-15. Shavit's system depends on these specific transaction types which the reghistered participant must provide at the time of registration, or Shavit's system would not function.

(b) The above basis of rejection cites the places in Shavit where the monitoring is explicitly found: In Fig. 8, it is in step 224, where the screening monitor software logic asks "IS THE SELECTED PARTY ACTIVE?". Col. 21, ll. 2-5, Shavit teaches that his system, "the selected party is checked in an automatic authorization procedure to verify that the user has selected a party recognized by he system". Both of these teachings disclose monitoring since these steps themselves represent monitoring and the

questions in the steps could not be answered if monitoring was not taking place. Monitoring of participant activity MUST take place in Shavit.

(B) Claim 26 is exemplary of independent claims 26, 31 and 36 (p. 26, l. 31; p. 27, ll. 19-20).

(a) Shavit fails to disclose, teach, or suggest "participation criteria ...that specifies ...transactions in which the buyer is willing to participate .... "as recited in claim 26.

(b) As another example, as discussed above with reference to claim 1, Shavit fails to disclose, teach, or suggest software operable to "monitor activities of the buyer in the purchase transaction to assess whether the buyer should continue to be pre-qualified to participate in purchase transactions," as recited in claim 26.

RESPONSE:

(a) This argument is invalid for the same reasons as the cited in the examiner's response to Argument (A) (a) regarding claim 1 above.

(b) This argument is invalid for the same reasons as the cited in the examiner's response to Argument (A) (b) regarding claim 1 above.

ARGUMENT re. Issue No. 2 – Obviousness of Claims 37-44:

(A) Claim 38 is exemplary of dependent claims 26, 31 and 36 (p. 30, ll. 1-5).

(a) "Appellants respectfully submit that the Examiner appears to have merely modified portions of Shavit, with the benefit of hindsight using Appellants' claims as a blueprint, to reconstruct Appellants' claims" (p. 31, 7-9). The cited portion of Shavit does not include even the slightest reference to pre-qualification of participants, monitoring activities of the participants in an ongoing transaction, or automatically modifying the pre-qualification of a participant (based on the monitoring) if such modification is determined to be appropriate. Appellants must conclude that the Examiner's proposed modifications to Shavit appear to be merely an attempt to reconstruct Appellants' claims, with the benefit of hindsight using Appellants' claims as a blueprint, and are unsupported by the teachings of Shavit" (p. 31, ll. 29-30, p. 32, ll. 1-5).

(b) "Additionally, the Examiner's supposed motivation for modifying Shavit is Shavit's statement of an advantage of its system (i.e. that dramatic new efficiencies can be

provided by the configuration of on-line interactive concurrent electronic services). (See Shavit, column 1, lines 61-68) It certainly would not have been obvious to one of ordinary skill in the art at the time of the invention, based solely on the prior art, to even attempt to modify Shavit to include pre-qualification of participants, monitoring activities of the participants in an ongoing transaction, or automatically modifying the prequalification of a participant (based on the monitoring) if such modification is determined to be appropriate. Even more clearly, it certainly would not have been obvious to one of ordinary skill in the art at the time of the invention, based solely on the prior art, to actually modify Shavit to include pre-qualification of participants, monitoring activities of the participants in an ongoing transaction, or automatically modifying the prequalification of a participant (based on the monitoring) if such modification is determined to be appropriate, which would be required to establish a prima facie case of obviousness under the M.P.E.P. and the governing Federal Circuit case law. This is particularly true in light of the fact that, as Appellants demonstrated above with respect to independent claim 1, Shavit fails to even disclose, teach, or suggest "participation criteria for each participant" wherein "each participant [is] pre-qualified to enter into the one or more types of transactions specified in the participation criteria for the participant" and a marketplace operable to "monitor activities of the at least one participant in the ongoing transaction to asses whether the participant should continue to be pre-qualified to participate in transactions of the same type as the ongoing transaction" as recited in claim 1, for example." (p. 32, ll. 6-27).

(c) "... the Examiner still has not shown the requisite teaching, suggestion, or motivation in Shavit or in knowledge generally available to one of ordinary skill in the art at the time of Appellants' invention to modify Shavit in the manner the Examiner proposes. Appellants respectfully submit that the Examiner's conclusory assertion that it would have been obvious to modify the teachings of Shavit to arrive at Appellants' invention is insufficient to support a prima facie case of obviousness under 35 U.S.C. § 103(a) according to the standards set forth by the M.P.E.P. and the governing case law. Thus, claims 38, 40, 42, and 44 are allowable for at least this additional reason.

" (p. 30, ll. 24-30). "... as Appellants demonstrated above with respect to independent claim 1, Shavit fails to even disclose, teach, or suggest "participation criteria for each participant" wherein "each participant [is] pre-qualified to enter into the one or more types of transactions specified in the participation criteria for the participant" and a marketplace operable to "monitor activities of the at least one participant in the ongoing transaction to asses whether the participant should continue to be pre-qualified to participate in transactions of the same type as the ongoing transaction" as recited in claim 1, for example." (p. 32, ll. 6-27).

RESPONSE:

(a) Applicants may argue that the examiner's conclusion of obviousness is based on improper hindsight reasoning. However, "[a]ny judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." ***In re McLaughlin*** 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

(b) "There is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. ***In re McLaughlin*** 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

(c) The March, 2006 ruling of *In re Kahn* clarifies the subject of obviousness combination as follows:

> "A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. . . . The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kotzab, 217 F.3d 1365, 1370 (Fed. Cir. 2000). However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. See Lee, 277 F.3d at 1343-46; Rouffett, 149 F.3d at 1355-59. This requirement is as much rooted in the

> Administrative Procedure Act, which ensures due process and non-arbitrary decisionmaking, as it is in § 103. See id. at 1344-45." In re Kahn, Slip Op. 04-1616, page 9 (Fed. Cir. Mar. 22, 2006).

In this instance, the examiner has met the standards reconfirmed by *In re Kahn* stated above. Appellant's argument against a proper prima facie case of obviousness having been made in the rejection of claims 37-44 under 35 USC 103(A) relies on the validity of Appellant's arguments against the rejection of claim 1, which is not substantiated per the above Response to Arguments. Further, the examiner has pointed to a combination of explicit, implicit, suggested and obvious reasons, and to the knowledge of the ordinary practitioner in consideration of the problems to be solved, supported by articulated reasoning with some rational underpinning to support the legal conclusion of obviousness in making the rejections of claims 37-44.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Siegfried E. Chencinski

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Siegfried E. Chencinski, Patent Examiner